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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,186	04/07/2004	Thomas R. Marsh	9066-23DV	7421

20792 7590 09/07/2004

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EXAMINER	
LUGO, CARLOS	

ART UNIT	PAPER NUMBER
3676	

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/820,186	MARSH ET AL.	
	Examiner	Art Unit	
	Carlos Lugo	3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) *12* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/7/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-11, drawn to a device for protecting furniture components, classified in class 292, subclass 288.

   II. Claim 12, drawn to a method of manufacturing a device, classified in class 264, subclass 572.

2. The inventions are distinct, each from the other because of the following reasons:

   Inventions in Groups I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as casting or shaping instead of an injection molding process.

   Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Miss Laura Kelley on August 24, 2004, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-11. Applicant in replying to this Office action must make affirmation of

this election. Claim 12 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

   A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

   Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. **Claims 1-11 are rejected** under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 8-17 of U.S. Patent No. 6,729,664. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 1 of the present application discloses a device for protecting first and second confronting furniture components comprising a base member having opposite first and second faces, the first face adapted to contact the first furniture component, the base member having a cushioning projection extending outwardly from the second face of the base member and covering a void within the base member, the projection adapted to contact the second furniture component as it confronts the first furniture component.

Claim 1 of US Pat No 6,729,664 claims a device for protecting first and second confronting furniture components comprising a base member having opposite first and second faces, the first face adapted to contact the first furniture component, the base member having a cushioning projection extending outwardly from the second face of the base member and covering and defining a void within the base member, the projection adapted to contact the second furniture component as it confronts the first furniture component.

It would have been obvious to one having ordinary skill in the art to have the cushioning projection covers and defines a void within the base member in order to create a cushioning environment in order to protect the furniture component.

Claims 2-11 of the present invention claims the same limitations of claims 8-17 of US Pat No 6,729,664.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. **Claims 1-8,10 and 11 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,533,374 to Hightower in view of US Pat No 2,536,941 to Jones.

Regarding claim 1, Hightower discloses a device comprising a base member (11) having opposite first and second faces. The first face is adapted to contact a frame member (13 or 15).

However, Hightower fails to disclose that the base member has a cushioning projection on the second face covering a void within the base member.

Jones teaches that is known in the art to have a device for fasten a door and a jamb (35 and 37 respectively) wherein the base member (27) includes a cushioning projection (31) covering a void within the base member.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a cushioning member, as taught by Jones, into a device as described by Hightower, in order to give protection to the furniture when the clip or device is applied.

As to claim 2, Jones teaches that the device is formed as a unitary member.

As to claim 3, Hightower discloses that the device is formed of a polymeric material (Col. 4 Lines 5-12).

As to claim 4, Jones teaches that the cushioning projection has a convex portion extending outwardly from the second face of the base member and a planar portion opposite the convex portion across the void (Figure 1).

As to claim 5, Jones teaches and illustrates that the planar portion of the cushioning projection has a thickness that is less than the thickness of the base member (Figures 1 and 5).

As to claim 6, Jones teaches and illustrates that the convex portion of the cushioning projection as a thickness that is less than the thickness of the base member (Figures 1 and 5).

As to claim 7, Jones teaches and illustrates that the cushion projection is elongated in a direction perpendicular to the base member (Figures 1 and 5).

As to claim 8, Jones teaches and illustrates that the cushioning projection is generally semi-circular (Figures 1 and 5).

As to claim 10, Jones teaches and illustrates that the cushioning projection is closed at both ends (Figures 1 and 5).

As to claim 11, Jones illustrates that the cushioning projection has a thickness of between about .020 and about .090 inches.

8. **Claim 9 is rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,533,374 to Hightower in view of US Pat No 2,536,941 to Jones as applied to claim 1 above, and further in view of US Pat No 4,120,524 to Buck.

Hightower, as modified by Jones, fails to disclose that the cushioning projection comprises an opening on at least one end.

Buck teaches that is known in the art to have a cushioning member (43) having an opening on at least one end.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a cushioning member, as taught by Buck, into a device as described by Hightower, as modified by Jones, in order to give a smooth cushion or to minimize shock of moving parts.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo whose telephone number is 703-305-9747. The examiner can normally be reached on 9-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

C.L.

Carlos Lugo
AU 3676

August 30, 2004.

Daniel P. Stodola

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